

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

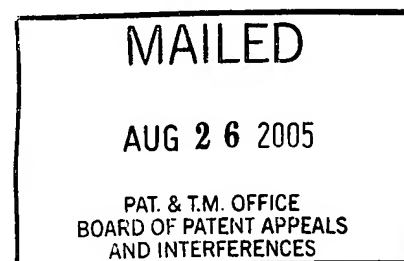
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte KEI USUI

Appeal No. 2005-2018  
Application No. 10/030,420

ON BRIEF



Before KIMLIN, GARRIS, and WALTZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1 and 2.

The subject matter on appeal relates to a method for improving the quality of a foodstuff which comprises the step of subjecting the foodstuff to a washing treatment with activated water. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

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1. A method for improving the quality of a foodstuff which comprises the step of subjecting the foodstuff to a washing treatment with activated water prepared by contacting water with an alloy having absorbed hydrogen which is produced by contacting an alloy with hydrogen gas, whereby said alloy bearing absorbed hydrogen releases hydrogen on contact with said water to activate said water.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Reznik	5,951,839	Sep. 14, 1999
Kawasaki	JP 09-001153	Jan. 7, 1997

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Reznik in view of Kawasaki.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellant and by the examiner concerning the above noted rejection.

#### OPINION

For the reasons set forth in the answer and below, this rejection will be sustained.

On page 4 of the answer, the examiner assesses the subject matter defined by the appealed claims and disclosed by Reznik in the following manner:

The Reznik patent by itself meets the [appellant's claimed] method for improving the quality of a foodstuff, because the reference discloses the claimed method for improving the quality of a foodstuff

comprising the steps of washing treatment with "activated" water (called reducing water by Reznik), wherein the water is formed by contacting water with a material having absorbed hydrogen which is produced by contacting said material with hydrogen gas, whereby said material bearing absorbed hydrogen releases hydrogen on contact with said water to activate said water ( see figure 2 and col. 3, lines 33-37 and col. 6, lines 42-55).

We agree with this assessment. In support of his opposing view, the appellant points out that Reznik discloses in the paragraph bridging columns 4 and 5 a method of storing produce which comprises washing/rinsing the produce with oxidizing/reducing water and argues that "[i]t is not apparent how the quality of the resultant produce is improved [by this produce storing method]" (brief, page 3). However, to the extent that patentee's produce or foodstuff is subjected to the same water treatment as defined by the appealed claims, Reznik's aforementioned method would necessarily and inherently effect the same quality improvement as the here claimed method. See MEHL/Biophile Int'l. Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1304, 1305-06 (Fed. Cir. 1999).

In this latter regard, the appellant further argues "[n]or is it at all clear that the [here claimed] activated water produced by contacting the alloy with absorbed hydrogen with water the same as water produced by the process of Reznik"

(brief, page 3). As properly indicated by the examiner, patentee's water, like the water defined by the appealed claims, is produced by contacting the water with a material having absorbed hydrogen. Under these circumstances, it is reasonable to believe that patentee's water necessarily and inherently possesses the same characteristics as the appellant's claimed water. See Ex parte Levy, 17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990).

Where, as here, the claimed and prior art products (i.e., the water claimed by the appellant and disclosed by Reznik) are identical or substantially identical, or are produced by identical or substantially identical processes, the Patent and Trademark Office can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977).

On the record before us, the appellant has proffered no proof of any kind that the water used by Reznik in treating his foodstuff or produce does not actually possess the same characteristics as the water defined by the appealed claims. Viewed from this perspective, the appellant's claimed method is indistinguishable from patentee's above discussed method. Under this view, the examiner's section 103 rejection of claims 1 and 2 is sustainable on the theory that a lack of novelty is the ultimate of obviousness. See In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982).

In addition to the foregoing, we agree with the examiner's ultimate conclusion that it would have been obvious to use an alloy, namely, a palladium alloy as the hydrogen absorbing material for Reznik's porous tube 10 which is contacted with water in accordance with patentee's teachings (e.g., see the disclosure referred to by the examiner at lines 42-55 in column 6 of the Reznik patent) in view of Kawasaki's palladium and hydrogen teachings. This obviousness conclusion is supported by the fact that Reznik expressly teaches that his tubes 10 may be made of metal through which hydrogen diffuses (see lines 57-59 in column 8). Further supporting this conclusion is the appellant's own acknowledgment in the paragraph bridging specification pages

3 and 4 that a great variety of hydrogen-absorbing alloys including palladium-based alloys are known in the prior art. Thus, an artisan would have been motivated based upon a reasonable expectation of success to manufacture tubes 10 in accordance with Reznik's column 8 teaching from a metal known to possess hydrogen diffusing/absorbing characteristics such as a palladium-based alloy. See In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988).

According to the appellant, "[i]t is difficult to imagine how one of ordinary skill in the art would combine the teachings of the Reznik primary reference with those of the Kawasaki reference for any reason, no less improving the quality of foodstuffs by washing with activated water which is prepared by hydrogen released from an alloy containing absorbed hydrogen, such as palladium" (brief, page 4). For the reasons discussed above and in the answer, however, we are convinced that the artisan would have been motivated to make Reznik's tubes of a palladium-based alloy based upon a reasonable expectation of successfully achieving patentee's hydrogen diffusing/absorbing desideratum.

In conclusion, it is our ultimate determination that the record before us evinces a prima facie case of unpatentability



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Wenderoth, Lind & Ponack, LLP  
2033 K Street, N.W.  
Suite 800  
Washington, DC 20006-1021